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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,644	05/31/2006	Mikko Nevalainen	P3072US00	8265

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DITTHAVONG MORI & STEINER, P.C.  
918 Prince Street  
Alexandria, VA 22314

EXAMINER
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CASCA, FRED A

ART UNIT	PAPER NUMBER
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2617

NOTIFICATION DATE	DELIVERY MODE
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01/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,644	<b>Applicant(s)</b> NEVALAINEN, MIKKO	
	<b>Examiner</b> FRED A. CASCA	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 14, 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This action is in response to applicant's amendment filed on October 14, 2009. Claims 1-16 and 19-36 are still pending in the present application. **This Action is made FINAL.**

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 16 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16 and 35 are drawn to a "computer readable medium" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not

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define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

The word "carrying" in claims 16 and 35 makes the claims non-statutory. A computer readable medium is able store instructions, but not able to carry instructions.

The following are example of acceptable language in computer-processing related claims:

1. "computer readable medium" encoded with \_\_\_\_\_
  - a. " a computer program"
  - b. "software"
  - c. "computer executable instructions"
  - d. "instructions capable of being executed by a computer"
2. "a computer readable medium" \_\_\_\_\_ "computer program"
  - a. "storing a"
  - b. "embodied with a"
  - c. "encoded with a"
  - d. "having a stored"
  - e. "having an encoded"

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 1-16 and 19-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 12, 19 and 26 have been amended to contain new matter. The phrase “the interchangeable memory being separated from a SIM card of the mobile device” added to independent claims 1, 12, 19 and 26 has not been described in the specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9, 11-16, 19-29, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imaeda (US 2004/0204093 A1) in view of Kelkar (US 2004/0198456 A1), further in view of Piikivia (US 2004/0065734) and still further in view of Thomas (US 6,453,160 B1).

Referring to claim 1, Imaeda discloses a method (abstract and figure 1) comprising:

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detecting that an interchangeable memory has been connected to a mobile terminals device which includes an interface for connecting to memory (paragraph 22, 23, 32, note communication takes place, thus memory card detection is inherent. Further note that the terminal connects to a memory unit and the connection has to take place via an interface) and a cellular network interface (Fig. 1, and par. 28, 26, 59),

retrieving a network address of a network server (paragraph 28, 32-34, “memory card 202 communicates and makes a connection with the data server 203”),

and automatically setting up a connection between the mobile terminal device and said server via said cellular network (Fig. 1, and paragraph 28, 32-34, “memory card 202 communicates and makes a connection with the data server 203”, note that the connection set up is automatic without any user intervention).

Imaeda does not specifically disclose that the memory unit is an interchangeable memory unit and the retrieving of the network address by the mobile terminal is in response to the detecting of memory connection in the format claimed.

Kelkar discloses that a cellular phone is equipped with an interface that allows receiving a memory card (Fig. 1 and Par. 15 and 21, "memory interconnect 50", "memory storage device 105") and retrieving of the network address by the mobile terminal is in response to the detecting of memory connection (Fig. 1-2, Par. 34-35).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Imaeda in the format claimed by incorporating the teachings of Kelkar, for the purpose of providing an efficient communication terminal.

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The above combination is silent on whether or not the interchangeable memory is being separated from a SIM card.

Piikivi discloses that smart cards (interchangeable memory) is being used separately from SIM cards (Par. 22 and 46).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

The above combination is silent on whether or not the cellular network application is being independent from a cellular network communication application activated via the SIM card of the mobile device.

In the same field of endeavor, Thomas discloses a cellular network application that is being independent from a cellular network communication application activated via the SIM card of the mobile device (Fig. 1-2, and col. 1, lines 29-35 and col. 1, line 66-col. 2, line 6, note that gaming server that run a gaming application (cellular network application) is different than the cellular network communication application that is commonly used for cellular communications).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the above combination in the format claimed such that the interchangeable memory of the Imaeda would set up an automatic connection with the gaming server of Thomas, for the purpose of providing convenience for subscribers.

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Referring to claim 2, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1, wherein said network address of said server is stored in said interchangeable memory, and that said network address of said server is retrieved from said interchangeable memory (Imaeda, paragraphs 26 and 32).

Referring to claim 3, the combination of I Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1, wherein said network address of said server is stored in said mobile terminal device, and that said network address of said server is retrieved from said mobile terminal device (figure 1 and paragraphs 22 and 26, 28, note cell phone inherently store base station addresses).

Referring to 4, the combination of Imaeda/Kelkar/Piikivi/Thomas according to claim 1, further comprising activating a cellular network application being stored on said interchangeable memory in an online mode (paragraphs 22 and 26, 28 and figures 1-6).

Referring to claim 5, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1, wherein said interchangeable memory contains application ID data of said cellular network application and in that said method further comprises retrieving said application ID data and transferring said application ID data to said connected server (paragraph 32).

Referring to claim 6, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1, further comprising sending a user confirmation request to a user interface for setting up a connection to said server address via said network, and setting up a connection to said server at said server address via said network, only if said requested user confirmation is detected (paragraph 50 and 53, “access rights”).

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Referring to claim 7, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1 anyone further comprising obtaining preference data of a user for said cellular network application, and storing said preference data within said interchangeable memory (paragraph 8, “image photographed by the digital camera”).

Referring to claim 8, the combination of Imaeda/Kelkar/Piikivi/Thomas disclose the method according to claim 1 further comprising retrieving preference data of a user for said cellular network application stored in said interchangeable memory, and transferring said preference data to said connected server (paragraphs 8, 32-33 and 58).

Referring to claims 12, 19 and 26, claims 12, 19 and 26 recite features analogous to the features defined by claim 1 (as rejected above). Thus, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses all elements of claims 12, 19 and 26 (please see the rejection of claim 1 above).

Referring to claim 13, claim 13 recites features analogous to the features defined by claim 7 (as rejected above). Thus, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses all elements of claim 13 (please see the rejection of claim 7 above).

Referring to claim 14, claim 14 recites features analogous to the features defined by claim 4 (as rejected above). Thus, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses all elements of claim 14 (please see the rejection of claim 4 above).

Referring to claim 16, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses a computer program product comprising program code means stored on a computer readable medium for carrying out the method of claim 1 when said program product is run on a computer

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or network device (see the rejection of claim 1 and note that all the automatic interfaces, connections and communications are inherently run by a computer code).

Referring to claims 20-23, claims 20-23 are rejected for the same reasons that claim 1 and 3-6 are rejected (please refer to the rejection of claims 1 and 3-6).

Referring to claim 25, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the mobile terminal device according to claim 19 and further disclose said cellular network application is a cellular network game (figure 1).

Referring to claims 27-29 and 31-32, claims 27-29 and 31-32 are rejected for the same reasons that claim 1 and 3-7 are rejected (please refer to the rejection of claims 1, 3-7).

Referring to claims 35, claims 35 is rejected for the same reasons that claim 16 is rejected for (please see the rejection of claim 16 above).

Referring to claim 36, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method of claim 1 and inherently discloses the interchangeable memory being detected while the mobile terminal is activated for wireless communication via SIM card (see the rejection of claim 1 above, and note that the initial connection to the cellular network has to be established via the base station (Thomas, Figure 1) in order to connect the gaming server through the base station).

Referring to claim 9, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the method according to claim 1 and further discloses the server connects in a mobile terminal.

Imaeda does not specifically disclose server resides in another mobile terminal.

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It would have been an obvious design choice to modify the above combination such that the server would reside in another mobile terminal since the applicant has not disclosed that having the server reside another mobile terminal would resolve any stated problem or is for any given purpose and it appears that having the server reside in a non-mobile terminal would work equally well.

Referring to claim 11, the combination of Imaeda/Kelkar/Piikivi/Thomas and well-known art discloses the device of claim 9, and further disclose retrieving data of a user for a cellular multiplayer game stored in said interchangeable memory, and transferring preference data of a user to said connected game server (figures 2-9 and see rejection of claim 1), and game server, determining game status data of said cellular network game, and storing said data in said interchangeable memory, wherein said cellular network application is the cellular network game (Thomas, Figures 1-2 and see the rejection of claim 1).

Claim 15 is rejected for the same reasons that claim 9 is rejected (see the rejection of claim).

Claims 24 is rejected for the same reasons that claims 9 is rejected (see the rejection of claims 9 above).

Referring to claim 33, claim 33 is rejected for the same reasons that claim 9 is rejected (please see the rejection of claim 9 above).

Referring to claim 34, the combination of Imaeda/Kelkar/Piikivi/Thomas discloses the device of claim 33, and further disclose a storage controller is provided to send said server

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address and said script to the interface (Imaeda, figures 2-8 and paragraph 32-34, note that a controller to manipulate a destination address is inherent).

7. Claims 10 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imaeda (US 2004/0204093 A1) in view of Kelkar (US 2004/0198456 A1), further in view of Piikivia (US 2004/0065734) and still further in view of Thomas (US 6,453,160 B1), and still further in view of well known prior art (MPEP 2144.03).

Referring to claim 10, the combination of Imaeda/Kelkar/Piikivi/Thomas and well-known art discloses the device of claim 9, and further disclose storing said data in said interchangeable memory (figures 2-9).

The combination is silent on hot-swapping the interchangeable memory card with another as claimed.

The examiner takes official notice of the fact that hot-swapping memory cards is well known in the art.

It would have been obvious to a person of ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication device.

Claim 30 are rejected for the same reasons that claim 10 is rejected (see the rejection of claim 10 above).

### ***Response to Arguments***

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8. Applicant's arguments with respect to claims 1-16 and 19-36 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

Application/Control Number: 10/561, 644  
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/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617